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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,699	05/25/2006	Shin Masaoka	1217-061625	5404
28289	7590	10/14/2008	EXAMINER	
THE WEBB LAW FIRM, P.C. 700 KOPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219				NWAONICHA, CHUKWUMA O
ART UNIT		PAPER NUMBER		
1621				
MAIL DATE		DELIVERY MODE		
10/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/580,699	MASAOKA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	CHUKWUMA O. NWAONICHA	1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 July 2008.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1-6 is/are allowed.  
 6) Claim(s) 7-16 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>07/11/2008</u> .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Current Status***

1. This action is responsive to Applicants' amendment of 11 July 2008.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-16 are pending in the application.

The objection of claims 8-10 is withdrawn following Applicants amendments.

The 102 rejection of claims 7 and 11 is withdrawn following Applicants amendments.

The allowability of claim 1-6 is maintained for the reason stated in the previous Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12-16 are indefinite because of the word "combination". It is not clear if Applicants are claiming a compound or a composition. Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

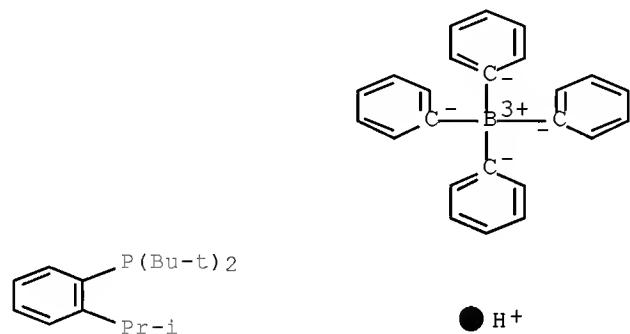
A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims** 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Gill et al., {Transition metal-carbon bonds. XXXIII. Internal metalations of secondary and tertiary carbon atoms by platinum(II) and palladium(II) Inorganic Chemistry (1972-1999) (1973), (3), 270-8}.

Gill et al. disclose applicants claimed compounds as shown below.



### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

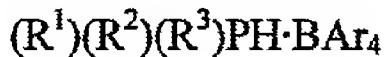
1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinashi et al., {JP 62149721}.

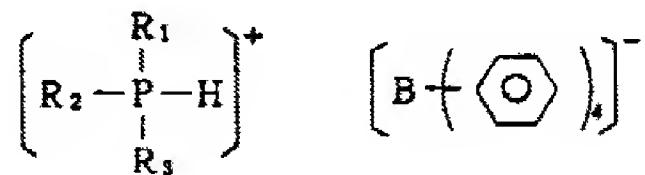
Applicants claim a phosphonium borate of formula I; wherein all the variables are as defined in the claims.



formula I

**Determination of the scope and content of the prior art (M.P.E.P. §2141.01)**

Kinashi et al. teach a phosphonium borate compound of formula II; in which the variables R<sub>1</sub>, R<sub>2</sub> and R<sub>3</sub> are C<sub>2</sub>-C<sub>10</sub> alkyl groups.



formula II

**Ascertainment of the difference between the prior art and the claims (M.P.E.P.. §2141.02)**

Kinashi et al. phosphonium borate compound differs from the instantly claimed phosphonium borate compound of formula I in that Kinashi et al. phosphonium borate compound is a subgenus of the instantly claimed phosphonium borate compound of

formula I. Specifically, applicants claim a phosphonium borate compound of formula I wherein the variables R<sub>1</sub>, R<sub>2</sub> and R<sub>3</sub> are C<sub>1</sub>-C<sub>20</sub> alkyl groups while Kinashi et al. teach a phosphonium borate compound wherein the variables R<sub>1</sub>, R<sub>2</sub> and R<sub>3</sub> are C<sub>2</sub>-C<sub>10</sub> alkyl groups.

**Finding of prima facie obviousness--rational and motivation (M.P.E.P.. §2142-2143)**

The instantly claimed phosphonium borate compound of formula I is obvious in view of the teaching of Kinashi et al.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by varying the substituents on the genus of Kinashi et al. to arrive at the instantly claimed phosphonium borate compound of formula I. Said person would have been motivated to practice the teaching of the reference cited because it demonstrates that phosphonium borate compound are useful in industrial application. The instantly claimed invention would therefore have been obvious to one of ordinary skill in the art.

Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chukwuma O. Nwaonicha/  
Examiner, Art Unit 1621

/Sikarl A. Witherspoon/  
Primary Examiner, Art Unit 1621  
(for) \_\_\_\_\_  
Daniel Sullivan  
Supervisory Patent Examiner,  
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